

# Notice of Allowability

Application No.

10/518,342

Examiner

Marc S. Zimmer

Applicant(s)

DUMONT ET AL.

Art Unit

1712

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/17/06.
2. ☒ The allowed claim(s) is/are 1-18.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date 11/17/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In claim 1, please replace "Crosslinkable" in line 1 with

-- A crosslinkable --.

In claims 2-8 and 15-17, please replace "Composition" in line 1 with

-- The composition --.

In claim 9, please replace "Varnishing" in line 1 with

-- A varnishing --.

In claim 10, please replace "Process" in line 1 with

-- A process --.

In claim 11, please replace "Process" in line 1 with

-- The process --.

In claim 12, please replace "Composite obtainable" in line 1 with

-- A composite obtained --.

In claims 13 and 18, please replace "Composite" in line 1 with

-- The composite --.

In claim 14, please replace "Manufactured" in line 1 with

-- A manufactured --.

Applicant is advised that the word “obtainable” in claim 12 has been replaced with “obtained” because the former would make the claim indefinite inasmuch as it raises questions as to whether processes other than that recited in claim 9 are to be contemplated.

***Allowable Subject Matter***

Applicant traverses the Examiner’s prior art rejection over Sato et al., in view of Budden et al. and, in doing so, presents two main arguments:

“One of ordinary skill in the art would not modify Sato et al. by adding powdered silica to its composition because the addition of fillers such as silica *can* [emphasis is the Examiner’s] increase friction, as expressly taught by Budden et al. See Col. 7, lines 13-16.”

The Examiner already addressed this point in his previous correspondence. What *Budden* actually says is that, when added in quantities exceeding 3% by weight, the coefficient of friction rises to unacceptable levels. There is no indication of any adverse effects below this level of incorporation and, hence, one of ordinary skill would not be deterred from the combination suggested by the Examiner.

“... Yet comparison of Example 4 to Example 3 of the present application demonstrates that the addition of a silica powder reduces the coefficient of friction and enhances a slippery and soft touch to the composite. See Table 1, page 23. This is an unexpected and surprising result in view of Budden et al.”

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The Examiner acknowledges that this does appear to be an undocumented effect.

While *Budden* does not discourage the addition of silica at specified levels of incorporation, the only benefit identified is that of a reinforcing effect, which one of ordinary skill will appreciate translates to an improvement in mechanical properties.

There is no mention whatsoever of either an enhancement in softness or a lowering of the coefficient of friction at any level of silica incorporation nor would the skilled artisan have predicted this outcome as silica usually imparts abrasive and hardening characteristics.

An updated survey of the prior art did not yield a reference more germane than those already made of record.

Applicant has furnished an IDS citing Chorvath et al., U.S. Patent # 6,465,552 and Chorvath et al., U.S. Patent Application Publication No. 2002/0086937 because they had been earlier cited in copending 11/000,441. While these references do indeed teach admixtures of polyamide and addition-curable silicone, the polyamide is not provided as particles that are dispersed in a silicone host matrix. Rather, the components of the crosslinkable silicone are mixed in a polyamide continuous matrix and dynamically crosslinked, which represents a considerable distinction.

The non statutory-type double patenting rejection is hereby withdrawn because this application has an older effective filing date, that of the PCT application on which

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this application is a national stage application, than does application serial no.

11/000,441. Insofar as there remain no obstacles to patentability, claims 1-18 are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

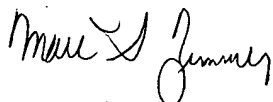
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 28, 2006

  
MARC S. ZIMMER  
MARC S. ZIMMER  
PRIMARY EXAMINER